

REMARKS

In accordance with the foregoing, the specification has been amended, claims 42, 47, and 52 have been canceled without prejudice or disclaimer, and new claims 53-55 have been added. Claims 1-11, 27-31, 36-41, 43-46, 48-51, and 53-55 are pending, with claims 1, 27, 38-41, 43-46, and 48-51 being independent. No new matter is presented in this Amendment.

Claim Rejections Under 35 USC 102

Claims 1-11, 27-31, and 36-52 have been rejected under 35 USC 102(b) as being anticipated by Shigenobu et al. (Shigenobu) (U.S. Patent No. 5,917,792), with the Examiner relying on the newly cited references to Senshu (U.S. Patent Application Publication No. 2003/0103429), Okamura et al. (Okamura) (U.S. Patent Application Publication No. 2003/0174625), and Kim et al. (Kim) (U.S. Patent Application Publication No. 2004/0168010) to support the rejection. The rejection of claims 42, 47, and 52 is moot since claims 42, 47, and 52 have been canceled in this Amendment. The rejection of claims 1-11, 27-31, 36-41, 43-46, and 48-51 is respectfully traversed.

The Examiner Has Improperly Failed to Include Senshu, Okamura, and Kim in the Statement of the Rejection

On pages 9 and 10 of the Office Action of June 26, 2009, the Examiner has relied on the newly cited references to Senshu, Okamura, and Kim to support the rejection with respect to the "sync body" and the "sync identification" features recited in various ones of claims 1-11, 27-31, and 36-52 in response to arguments presented by the applicants in the Amendment Accompanying Request for Continued Examination of May 6, 2009. However, the Examiner did not include Senshu, Okamura, and Kim in the statement of the rejection of claims 1-11, 27-31, and 36-52 on page 2 of the Office Action of June 26, 2009, as required by MPEP 706.02(j), which states as follows on MPEP page 700-48:

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

Footnote 3 in *Hoch* referred to in the above passage states as follows in pertinent part:

Where a reference is relied on to support a rejection, whether or not in a "minor capacity," there would appear to be no excuse for not positively including the reference in the statement of the rejection.

Thus, MPEP 706.02(j) has paraphrased the actual statement in *Hoch*. Since the Examiner did not include Senshu, Okamura, and Kim in the statement of the rejection of claims 1-11, 27-31, and 36-52 on page 2 of the Office Action of June 26, 2009, as required by MPEP 706.02(j), it is submitted that the rejection of claims 1-11, 27-31, 36-41, 43-46, and 48-51 is improper, and must be withdrawn.

It is noted that the title of MPEP 706.02(j) referred to above in which the discussion of *Hoch* is entitled "Contents of a 35 U.S.C. 103 Rejection." However, it is submitted that this does not mean that *Hoch* is not applicable to a rejection under 35 USC 102(b). The Examiner is clearly relying on Senshu, Okamura, and Kim to support the rejection under 35 USC 102(b). The court in *Hoch* stated "[w]here a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection" (emphasis added). It is submitted that nothing whatsoever in this statement indicates that the court intended for this statement to be limited to obviousness rejections under 35 USC 103(a). Accordingly, it is submitted that the USPTO cannot limit this statement in *Hoch* to obviousness rejections under 35 USC 103(a) merely by discussing *Hoch* in a section of the MPEP entitled "Contents of a 35 U.S.C. 103 Rejection."

Accordingly, since the Examiner did not include Senshu, Okamura, and Kim in the statement of the rejection of claims 1-11, 27-31, and 36-52 under 35 USC 102(b) as being anticipated by Shigenobu in the Office Action of June 26, 2009, it is submitted that the Examiner cannot rely on Senshu, Okamura, and Kim to support the rejection. Since the Examiner has apparently admitted that he needs to rely on Senshu, Okamura, and Kim to support the rejection, it is submitted that the Examiner has not established a *prima facie* case of anticipation with respect to claims 1-11, 27-31, 36-41, 43-46, and 48-51.

Okamura and Kim Are Not Available as References Against Claims 1-11, 27-31, 36-41, 43-46, 48-51, and 53-55

The U.S. filing date of Okamura is March 7, 2003, and the earliest possible effective U.S. filing date of Kim is June 4, 2003. However, both of these dates are after the filing date of December 10, 2002, of Korean Patent Application No. 2002-78167, the Korean priority application of the present application. A certified copy of Korean Patent Application No. 2002-78167 was filed on September 30, 2003. As discussed on page 10 of the Supplemental Amendment of June 5, 2008, an English translation of Korean Patent Application No. 2002-78167 and a Certification of Translation containing a statement that the English translation is accurate were submitted with the Supplemental Amendment of June 5, 2008, to perfect the applicants' claim for foreign priority under 35 USC 119(a)-(d). It is submitted that claims 1-11, 27-31, 36-41, 43-46, 48-51, and 53-55 are supported by the English translation of Korean Patent Application No. 2002-78167. Accordingly, it is submitted that Okamura and Kim are not available as references against claims 1-11, 27-31, 36-41, 43-46, 48-51, and 53-55 of the present application, and it is respectfully requested that the rejection of claims 1-11, 27-31, 36-41, 43-46, and 48-51 under 35 USC 102(b) as being anticipated by Shigenobu as supported by Okamura and Kim be withdrawn.

It is noted that MPEP 2124 states as follows on MPEP page 2100-58 (emphasis added):

In certain circumstances, references cited to show a universal fact need not be available as prior art before applicant's filing date. *In re Wilson*, 311 F.2d 266, 135 USPQ 442 (CCPA 1962). Such facts include the characteristics and properties of a material or a scientific truism.

Here, it is submitted that the "sync body" and the "sync identification" features recited in various ones of claims 1-11, 27-31, 36-41, 43-46, and 48-51 are not "the characteristics and properties of a material or a scientific truism," and it is not seen how these features can reasonably be considered to be the type of "universal fact" contemplated in MPEP 2124 and *Wilson*. Accordingly, it is submitted that Examiner cannot rely on Okamura and Kim to support the rejection of claims 1-11, 27-31, 36-41, 43-46, and 48-51 under 35 USC 102(b) because they are not available as references against claims 1-11, 27-31, 36-41, 43-46, and 48-51 of the present application for at least the reasons discussed above.

The Rejection Is Based on a Flawed Analysis of Shigenobu by the Examiner

The Examiner states as follows on page 3 of the Office Action of June 26, 2009:

In regard to claim 1, Shigenobu et al. disclose an information storage medium (Figure 2) for use with a recording and/or reproducing apparatus, the information storage medium comprising: a user data area (as shown) comprising a plurality of user data frames (see Figure 4), each of the user data frames comprising corresponding sync data of a plurality of sync data (denoted by SY); and an additional data area ("preamble") located before and/or after the user data area (as shown), and comprising at least two additional data frames (first frame in preamble labeled SY4, SY4 and second frame in preamble labeled SY3, SY3).

Thus, the Examiner apparently considers each of the rows in FIG. 4 of Shigenobu to correspond to one frame having two sync data. However, it is submitted that each of these rows corresponds to two frames each having one sync data SY_n. See, for example, column 5, lines 1-11, of Shigenobu, which states as follows (emphasis added):

The sync patterns SY4 to SY1 are respectively added to the frame headers in the 1st to the 4th row of the preamble part. The sync pattern SY0 is added to the 1st frame in the 1st row of each sector of the data part, and the sync patterns SY1 to SY4 are sequentially arranged at the heads (odd-numbered frames) of the 2nd and subsequent rows (2nd row to 13th row). A sync pattern SY5 is stored in the 2nd (even-numbered) frame of the 1st to the 5th row, a sync pattern SY6 is stored in the 2nd frame of the 6th to the 9th row, and a sync pattern SY7 is stored in the 2nd frame of the 10th to the 13th rows.

Also, see column 5, lines 19-22, of Shigenobu, which states as follows (emphasis added):

FIG. 5 shows a typical arrangement of each sector [in FIG. 4]. As seen from this figure, each sector comprises 13 rows and each row comprises 2 frames, so one sector comprises 26 frames.

Accordingly, it is submitted that the rejection of claims 1-11, 27-31, 36-41, 43-46, and 48-51 under 35 USC 102(b) as being anticipated by Shigenobu is based on a flawed analysis of Shigenobu by the Examiner, such that the Examiner has not established a *prima facie* case of anticipation with respect to claims 1-11, 27-31, 36-41, 43-46, and 48-51.

Claims 1, 27, 41, 46, and 51

It is submitted that Shigenobu does not disclose or suggest the following features of independent claim 1:

a user data area comprising a plurality of user data frames, each of the user data frames comprising corresponding sync data of a plurality of sync data; and

an additional data area located before and/or after the user data area, and comprising at least two additional data frames, a first one of the additional data frames comprising first sync data, and a second one of the additional data frames comprising second sync data, the first sync data and the second sync data being different from the plurality of sync data of the user data frames, the first sync data and the second sync data enabling the apparatus to identify the additional data area from the user data area when the information storage medium is used with the apparatus.

FIG. 4 of Shigenobu shows a preamble area that the Examiner considers to correspond to the "additional data area" recited in claim 1, and a data area (including the 1st to 16th sectors) that the Examiner considers to correspond to the "user data area" recited in claim 1. The preamble area includes 4 rows each including 2 frames, for a total of 8 frames. Each of the 8 frames of the preamble area (the "additional data area") includes one sync data selected from sync data SY1, SY2, SY3, and SY4. The data area (the "user data area") includes 208 rows (16 sectors x 13 rows per sector) each including 2 frames, for a total of 416 frames. Each of the 416 frames of the data area includes one sync data selected from sync data SY0, SY1, SY2, SY3, SY4, SY5, SY6, and SY7. Since the sync data SY0, SY1, SY2, SY3, SY4, SY5, SY6, and SY7 of the frames of the data area (the "user data area") include the sync data SY1, SY2, SY3, and SY4 of the preamble area (the "additional data area"), it is submitted that Shigenobu does not disclose or suggest the feature "the first sync data and the second sync data being different from the plurality of sync data of the user data frames" recited in claim 1.

Furthermore, it is submitted that Shigenobu does not disclose or suggest the feature "the first sync data and the second sync data enabling the apparatus to identify the additional data area from the user data area when the information storage medium is used with the apparatus" recited in claim 1 because Shigenobu's apparatus identifies whether a particular area is a preamble, a data area, or a postamble by detecting various combinations of the sync data SY0, SY1, SY2, SY3, SY4, SY5, SY6, and SY7. See, for example, the abstract and column 9, lines

32-47, of Shigenobu. Thus, none of the sync data SY1, SY2, SY3, and SY4 of the preamble area ("the additional data area") enables Shigenobu's apparatus to identify the preamble area ("the additional data area") from the data area (the "user data area").

Independent claims 27, 41, 46, and 51 recite features that are the same as or similar to the features of claim 1 discussed above, and it is submitted that Shigenobu does not disclose or suggest these features of claims 27, 41, 46, and 51 for at least the same reasons discussed above that Shigenobu does not disclose or suggest the same or similar features of claim 1.

Claims 38-40, 43-45, and 48-50

It is submitted that Shigenobu does not disclose or suggest the following features of independent claim 38:

an additional data area comprising:

- a first additional data frame comprising first sync data; and
- a second additional data frame comprising second sync data; and
- a data area comprising a data frame comprising third sync data;

wherein:

- the first sync data is different from the second sync data;
- the third sync data is different from the first sync data and the second sync data to enable the apparatus to identify the additional data area from the data area when the information storage medium is used with the apparatus.

Assuming *arguendo* that any one of the sync data SY0, SY1, SY2, SY3, SY4, SY5, SY6, and SY7 of the data area (the "data area") in FIG. 4 of Shigenobu that does not appear in any 2 of the 8 frames of the preamble area (the "additional data area") corresponds to the "third sync data" recited in claim 38, it is submitted that FIG. 4 of Shigenobu does not disclose or suggest the feature "the third sync data is different from the first sync data and the second sync data to enable the apparatus to identify the additional data area from the data area when the information storage medium is used with the apparatus" recited in claim 38 because Shigenobu's apparatus identifies whether a particular area is a preamble, a data area, or a postamble by detecting

various combinations of the sync data SY0, SY1, SY2, SY3, SY4, SY5, SY6, and SY7. See, for example, the abstract and column 9, lines 32-47, of Shigenobu. Thus, none of the sync data SY0, SY1, SY2, SY3, SY4, SY5, SY6, and SY7 of the data area (the "data area") enables Shigenobu's apparatus to identify the preamble area ("the additional data area") from the data area (the "data area").

Claims 39, 40, 43-45, and 48-50 recite features that are the same as or similar to the features of claim 38 discussed above, and it is submitted that Shigenobu does not disclose or suggest these features of claims 39, 40, 43-45, and 48-50 for at least the same reasons discussed above that Shigenobu does not disclose or suggest the same or similar features of claim 38.

Conclusion—Claim Rejections Under 35 USC 102

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-11, 27-31, 36-41, 43-46, and 48-51 (i.e., claims 1, 27, 38-41, 43-46, and 47-51 discussed above and claims 2-11, 28-31, 36, and 37 depending directly or indirectly from claims 1 and 27) under 35 USC 102(b) as being anticipated by Shigenobu be withdrawn.

Patentability of New Claims 53-55

It is submitted that Shigenobu does not disclose or suggest the following features of new dependent claims 53 and 54:

wherein the first sync data, the second sync data, and the plurality of sync data of the user data frames enable the apparatus to identify the additional data area from the user data area when the information storage medium is used with the apparatus without detecting any combination of any of the first sync data, the second sync data, and the plurality of sync data of the user data frames,

of the following feature of new dependent claim 55:

wherein the first sync data, the second sync data, and the third sync data enable the apparatus to identify the additional data area from the data area when the information storage medium is used with the apparatus without detecting any combination of any of the first sync data, the second sync data, and the third sync data.

The above features of claims 53-55 relate to aspects of the invention in which it is possible to identify whether a particular area is an additional data area or a data area merely by detecting one sync data in the particular area. For example, if the first sync data or the second sync data is detected in the particular area, then the particular area is identified as an additional data area. Or, if any of the plurality of sync data, or the third sync data, is detected in the particular area, the particular area is identified as a user data area or a data area.

In contrast, Shigenobu's apparatus identifies whether a particular area is a preamble, a data area, or a postamble by detecting various combinations of the sync data SY0, SY1, SY2, SY3, SY4, SY5, SY6, and SY7. See, for example, the abstract and column 9, lines 32-47, of Shigenobu.

For at least the foregoing reasons, it is submitted that new claims 53-55 are patentable over Shigenobu, and an indication to that effect is respectfully requested.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

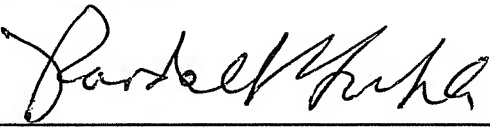
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN MCEWEN, LLP

Date: 09/28/09

By: 
Randall S. Svihla
Registration No. 56,273

1400 Eye St., NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510